

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	Confirmation No. 7173
)	
Glenn McGARRY, <i>et al.</i>)	
)	
Application No.: 09/764,782)	Group Art Unit: 3693
)	
Filed: January 17, 2001)	Examiner: J. Borlinghaus
)	
For: SYSTEM FOR CAPTURING DEAL)	
INFORMATION)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52

This Request for Rehearing is timely submitted in response to Decision on Appeal dated
March 25, 2010.

Appellants respectfully submit that, in rendering its Decision on Appeal dated March 25, 2010, the Board misapprehended and/or overlooked the following points pertaining, in particular, to claims 56 – 58.

Claims 56 – 58 require that the “deal management computer” is in communication “with a plurality of internal systems, each of the internal systems being associated with one or more product types, and the captured information being routed to at least one of the plurality of internal system.” These claims were rejected by the Examiner as being unpatentable under 35 U.S.C. § 103(a) in view of U.S. Pat. Pub. No. 2003/0033212 (“Sandhu”) and U.S. Pat. No. 7,024,462 (“McErlean”). This rejection was sustained by the Board in the Decision on Appeal (Decision on Appeal, p. 9). In sustaining this rejection, the Board first determined that “Sandhu discloses that the system may be used with financial products (FF2).” The Board then reasoned that “[i]f not inherent in the Sandhu system, the use of a separate internal system being associated with each product type would be an obvious expedient to permit separate processing if one system failed.” Appellants respectfully submit that the Board’s determination in this regard is not supportable under the law.

First, to the extent the Board is asserting that the features of claims 56 – 58 are inherent in Sandhu, the standard for inherency has not been met. As set forth in M.P.E.P. 2112, “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic”, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is *necessarily present* in the thing described in the

reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted, emphasis added). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). While the Sandhu system may be used in connection with financial products, it does not necessarily follow that “each of the internal systems [of Sandhu are] associated with one or more product types”, as required by the claims. Whether the Sandhu system may possibly, or even probably, be so configured is not the relevant inquiry for purposes of establishing inherency. Appellants respectfully submit that a sufficient basis to support a determination that Sandhu inherently discloses the claimed feature has not been provided.

Secondly, with regard to the Board’s assertion that “the use of a separate internal system being associated with each product type would be an obvious expedient to permit separate processing if one system failed”, Appellants respectfully submit that whether the claimed feature would be an obvious variant of Sandhu is also not the relevant inquiry. Instead, the claimed feature must be taught or suggested in the cited art. Section 2143.03 of the M.P.E.P. provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (emphasis

added). “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *Ex parte Zheng*, Appeal 2009-011236, Decided March 29, 2010 (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)); *see also Ex parte Inchley*, Appeal 2009-012601, Decided March 21, 2010 (“As the Federal Circuit has noted, ‘obviousness requires a suggestion of all limitations in a claim.’” (quoting *CFMT, Inc. v. Yieldup Int’t Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003))). In reaching its conclusion that claims 56 – 58 were obvious, the Board admittedly failed to find all of the claimed features in the cited art. Instead, the Board relied on the assertion that the claimed features would be an “obvious expedient.” Because all of the claimed features are not taught or suggested in the cited art, a prima facie case of obviousness has not been established.

#

CONCLUSION

For these reasons, Appellants respectfully request that the Board reconsider its Decision on Appeal and reverse the rejections asserted in the Final Office Action, at least as to dependent claims 56 - 58. If there are any other fees due in connection with the filing of this Request for Rehearing, please charge the fees to our Deposit Account No. 50-0310.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: April 21, 2010

By: /Alison B. Weisberg/
Alison B. Weisberg
Reg. No. 45,206
Carolyn Bleck Kosowski
Reg. No. 60,818

Customer No.: 009626
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: 202.739.3000
Facsimile: 202.739.3001